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No. 04-1350

Supreme Court, U.S.
FILED
AUG 2 2 2006
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IN THE

Supreme Court of the United States

KSR INTERNATIONAL CO.,

Petitioner,

v.

TELEFLEX INC. and
TECHNOLOGY HOLDING CO.,

Respondents.

On Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit

BRIEF OF INTEL CORPORATION AND MICRON TECHNOLOGY, INC. AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

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QUESTION PRESENTED

Whether the Federal Circuit has erred in holding that a claimed invention cannot be held "obvious," and thus unpatentable under 35 U.S.C. § 103(a), in the absence of some proven "'teaching, suggestion, or motivation,' that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed."

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BRIEF OF INTEL CORPORATION AND MICRON TECHNOLOGY, INC. AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

INTEREST OF *AMICI CURIAE*[1]

The question presented in this case is whether the Federal Circuit's "teaching, suggestion, or motivation" test for evaluating the patentability of claimed subject matter can be reconciled with this Court's precedent, the plain language of 35 U.S.C. § 103, and the Constitution's Patent Clause. Intel Corporation and Micron Technology, Inc.—innovative high-technology companies that together hold thousands of patents and annually devote billions of dollars to research-and-development programs—have a significant interest in the correct resolution of this question.

Intel is the world's largest semiconductor manufacturer and is also a leading manufacturer of computer, networking, and communications products. Intel is one of the ten most prolific producers of technology patents in the United States.

Micron is one of the world's leading semiconductor manufacturers. It produces an array of memory storage devices and image sensors, and its products can be found in everything from personal computers to digital cameras and network servers.

Intel and Micron rely upon the United States patent laws to protect their intellectual property and believe that a strong

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[1] Pursuant to this Court's Rule 37.3(a), letters of consent from all parties to the filing of this brief have been submitted to the Clerk. Pursuant to this Court's Rule 37.6, *amici* state that this brief was not authored in whole or in part by counsel for any party, and that no person or entity other than *amici* or their counsel made a monetary contribution to the preparation or submission of this brief.

patent system is essential to the vitality of the country's knowledge-based economy. As patent holders and frequent patent litigants, Intel and Micron have a strong interest in preserving the overall quality of United States patents. Intel and Micron are deeply concerned that the Federal Circuit's judicially manufactured obviousness standard, which requires the identification of a specific "teaching, suggestion, or motivation" to combine prior art references, has facilitated the proliferation of patents claiming nothing more than the straightforward combination of references already well-known in the relevant art. Affording patent protection to such simple combinations substantially dilutes overall patent quality.

Moreover, because Intel and Micron litigate patent infringement suits as both plaintiffs and defendants, they have a significant interest in ensuring that the patent laws are applied in an evenhanded manner that strikes a reasonable balance between intellectual property rights, innovation, and competition. Through the "teaching, suggestion, or motivation" test, however, the Federal Circuit has skewed litigation in favor of patent holders by unilaterally imposing nearly insurmountable legal burdens on defendants seeking to establish the obviousness of a patent. Intel and Micron are also concerned that the "teaching, suggestion, or motivation" test poses a serious obstacle to technological innovation. From their experiences, Intel and Micron have developed valuable insight into the practical repercussions of the Federal Circuit's obviousness jurisprudence and a keen awareness of the pressing need for this Court to reject the "teaching, suggestion, or motivation" test in favor of the obviousness standard endorsed in *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

STATEMENT

1. The patent laws impose three threshold conditions on patentability: novelty, utility, and non-obviousness. 35 U.S.C. § 101; *id.* § 103. While the novelty requirement inquires whether the invention was previously known and the

utility requirement ensures that society derives a benefit from the invention, the requirement of non-obviousness distinguishes between routine improvements within easy reach of a person knowledgeable in the relevant field and those significant technological advances that truly "add to the sum of useful knowledge." *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966).

The non-obviousness requirement has deep roots in this Court's jurisprudence, *see Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1851), and, in 1952, that jurisprudence was codified as 35 U.S.C. § 103. That provision provides:

> A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

35 U.S.C. § 103(a). By focusing upon the knowledge of a person skilled in the relevant field, Section 103 ensures that patents are granted only to reward innovative developments not reasonably apparent to someone trained in the art and that the patent laws are not used "to remove existent knowledge from the public domain, or to restrict free access to materials already available." *Graham*, 383 U.S. at 6; *see also Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150 (1989) ("The nonobviousness requirement extends the field of unpatentable material beyond that which is known to the public under § 102, to include that which could readily be deduced from publicly available material by a person of ordinary skill in the pertinent field of endeavor.").

2. Notwithstanding the plain language of Section 103, the Federal Circuit—in a self-described effort to guard against the "subtle but powerful attraction of a hindsight-based obviousness analysis" (Pet. App. 6a-7a (internal quota-

tion marks omitted))—has engrafted onto the statutory text an additional prerequisite to reaching a legal conclusion of obviousness. According to the Federal Circuit, an invention that combines two or more prior art references can be deemed obvious only where a court has "ma[d]e specific findings showing a teaching, suggestion, or motivation to combine prior art teachings in the particular manner claimed by the patent at issue." Pet. App. 16a. This so-called "teaching, suggestion, or motivation" requirement significantly diminishes the likelihood that a patent claiming a simple combination of prior art references will be deemed obvious. The Federal Circuit will not hold a patent that "combines two known elements" to be obvious unless the patent examiner or party challenging the patent's validity is able to point to a *specific* feature of "the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *In re Rouffet*, 149 F.3d 1350, 1356 (Fed. Cir. 1998) (internal quotation marks omitted).

The Federal Circuit's unilateral imposition of the "teaching, suggestion, or motivation" standard effectively overrides the statutory language of Section 103, which requires obviousness to be examined from the perspective of a person possessing ordinary skill in the relevant art, and has facilitated the issuance of countless patents claiming nothing more than a simple combination of preexisting elements that properly belongs in the public domain. This Court should explicitly reject the Federal Circuit's test in favor of the statutorily grounded obviousness framework set forth in *Graham*.

SUMMARY OF ARGUMENT

To secure the Patent Clause's objective of promoting innovation, patents must be restricted to those claims that truly advance the body of relevant knowledge. Claims encompassing simple combinations of the prior art that would have been apparent to anyone trained in the relevant field do not reflect innovation and do not warrant patent protection. The obvi-

ousness standard—codified at 35 U.S.C. § 103—polices this distinction between patentable inventions and the unpatentable byproducts of routine technological progress. This distinction has largely collapsed, however, under the weight of the Federal Circuit's "teaching, suggestion, or motivation" test, which restricts obviousness findings to those cases in which there is a specific prior art reference highlighting the desirability of combining elements already known in the art. This standard has produced a glut of patents claiming seemingly obvious combinations of prior art, and it squarely conflicts with the Patent Clause's implicit patentability requirements, this Court's obviousness jurisprudence, and the plain language of Section 103.

Far from promoting innovation, the Federal Circuit's "teaching, suggestion, or motivation" test has impeded technological development by removing prior art combinations from the public domain. As a result, companies often must divert a portion of their research-and-development funds to obtaining licenses for the use of technological combinations that should be freely available to all. Where a company inadvertently trips over one of these countless combination patents during its research, it faces the unwelcome prospect of settling an infringement claim based on a legally dubious patent or challenging the patent's validity in court under the auspices of the exacting "teaching, suggestion, or motivation" test. That judicially crafted standard significantly skews litigation in favor of patent holders by restricting the application of the obviousness doctrine to those patents claiming combinations specifically taught or suggested in the prior art. Moreover, under the Federal Circuit's test, the outcome of the obviousness inquiry—which, properly conceived, is ultimately a question of law—is controlled by disputed factual issues about the implications of prior art teachings and the subjective motivations of persons skilled in the relevant art. The predominance of factual issues makes it nearly impossible for a party challenging a patent's validity to establish ob-

viousness at the summary judgment stage. Thus, even where a defendant in an infringement action is able to demonstrate obviousness to a court's satisfaction, it almost invariably must incur the substantial costs of a trial to do so.

Innovation would be far better served by an obviousness standard that placed meaningful restrictions on patentability by excluding combinations that are apparent to a person with ordinary skill in the relevant art—without regard to whether a specific "teaching, suggestion, or motivation" to combine prior art teachings in the particular manner claimed is identified in one of the prior art references. Indeed, in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), this Court explicitly instructed the lower courts to utilize an obviousness standard that focuses upon the level of ordinary skill in the art and the differences between the prior art and the claimed invention. The Court should reaffirm the *Graham* framework, which strikes the appropriate balance between intellectual property rights and innovation, and reject the Federal Circuit's legally insupportable "teaching, suggestion, or motivation" test.

ARGUMENT

I. The "Teaching, Suggestion, Or Motivation" Test Stifles Innovation And Unduly Rewards Routine Technological Advances.

Consistent with the Patent Clause's objective of "promot[ing] the Progress of Science and useful Arts," U.S. Const. art. I, § 8, Congress developed a patent system that fosters innovation by temporarily granting inventors exclusionary rights for novel, useful, and non-obvious works. *See Atl. Works v. Brady*, 107 U.S. 192, 200 (1883) ("The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts."). Because monopoly-like rights have been viewed with disfavor throughout the Nation's history (*Graham*, 383 U.S. at 7), however, neither the Constitution nor the patent laws countenances the

issuance of patents that do not promote innovation or that otherwise impede technological progress. As this Court has explained, "[i]nnovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in [the] patent system." *Id.* at 6; *see also Gardner v. Herz*, 118 U.S. 180, 191 (1886) ("under art. I, sec. 8, subdivision 8 of the Constitution, a patentee must be an inventor and he must have made a discovery" (internal quotation marks omitted)).

The Federal Circuit's judicially manufactured "teaching, suggestion, or motivation" test conflicts with the patentability conditions implicit in the Patent Clause. *See Graham*, 383 U.S. at 6 ("patent validity requires reference to a standard written into the Constitution" (internal quotation marks omitted)). By sustaining patents that claim simple combinations apparent to anyone reasonably skilled in the relevant art, the Federal Circuit has impeded innovation and weakened competition to the detriment of the U.S. economy and American consumers. The deleterious consequences of the Federal Circuit's obviousness jurisprudence are inimical to the objectives of the Patent Clause and demonstrate the legal infirmity of the "teaching, suggestion, or motivation" test. Indeed, the serious practical ramifications of utilizing that obviousness standard are evident at every stage of the patent process: at the Patent and Trademark Office, where the "teaching, suggestion, or motivation" test imposes legal obstacles that preclude examiners from rejecting seemingly trivial claims, given the available art and resources; at the pre-litigation stage, where companies often choose to settle threatened infringement actions rather than attempt to demonstrate obviousness under the Federal Circuit's onerous standard; during trials, where the fact-intensive nature of the "teaching, suggestion, or motivation" test makes it nearly impossible for a district court to grant summary judgment on obviousness grounds; and before the Federal Circuit, which regularly upholds the validity of patents claiming simple combinations of prior art reflecting little or no innovation.

1. Under the Federal Circuit's "teaching, suggestion, or motivation" standard, neither the knowledge inherently possessed by a person with ordinary skill in the relevant art nor "common sense" standing alone is a sufficient ground upon which to rest an obviousness determination. *See In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002). To justify the conclusion that a particular combination was obvious in the prior art, a patent examiner or party challenging a patent's validity must point to a *specific* prior art reference teaching the particular combination in question. Pet. App. 12a. This exacting and rigid legal standard has resulted in a proliferation of patents that claim simple combinations of prior art references.

Some of the more stark examples include:

- An orange trash bag decorated with lines and facial features that cause the bag, when filled with leaves, to resemble a jack-o'-lantern. Although children's art designs for giving brown paper bags the appearance of a jack-o'-lantern were already well-known, the Federal Circuit concluded that the trash bag was patentable because the Board of Patent Appeals and Interferences had not "particularly identif[ied] any suggestion, teaching, or motivation to combine the children's art references . . . with the conventional trash or lawn bag references." *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999).

- An automobile antitheft device that is mounted across the steering wheel and locked in place using a self-locking ratcheting mechanism. Although both the design of the antitheft device and the self-locking mechanism were known in the prior art, the Federal Circuit held that the invention was not obvious because it had not been established under the "teaching, suggestion, or

motivation" test that "one of ordinary skill would [have been] motivated to combine" the two prior art references. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1350 (Fed. Cir. 2000).

- A baseball with specific "finger placement indicia" to teach students how to grasp the ball when throwing different pitches. Although a baseball that bore a "striking" resemblance to the invention had been patented thirty years earlier and another training device that used similar "finger placement indicia" was also well-known in the art, the Federal Circuit concluded that the invention was non-obvious because a motivation to combine the two pre-existing patents had not been established. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1345, 1356 (Fed. Cir. 2001).[2]

Affording patent protection to such simple combinations cannot be said to "promote the Progress of Science and useful Arts." U.S. Const. art. I, § 8. Such patents instead provide an unwarranted windfall to claimants who have done little to enhance the available body of useful knowledge. *Graham*, 383 U.S. at 6. Through imposition of its exacting "teaching, suggestion, or motivation" test, the Federal Circuit has effectively blurred the line between the novelty and non-

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[2] There is also a rich supply of similarly questionable patents that have never been litigated in federal court but that were approved by the Patent and Trademark Office under the Federal Circuit's "teaching, suggestion, or motivation" test. *See, e.g.*, *Ex parte Prior*, No. 2005-1405 (Bd. of Patent App. & Interferences 2005) (rejecting a patent examiner's conclusion that a patent claiming a method for using plaster to fill a hole in a wall was obvious because the examiner had not identified a specific suggestion to combine the relevant prior art references).

obviousness requirements: Courts are required to uphold a patent as long as it embodies an idea not precisely taught by the prior art—no matter how trivial or obvious the patent and no matter how insubstantially it advances the existing state of knowledge.

The "teaching, suggestion, or motivation" test—with its narrow focus on prior art teachings—is simply too rigid to constitute an effective means of identifying obvious patent claims. Patent examiners have only limited resources to devote to searching for prior art references teaching the combination in question, and their efforts to distinguish patentable and unpatentable claims are further hampered by the Federal Circuit's refusal to countenance reliance upon the inherent knowledge of a person skilled in the relevant art or the use of simple common sense in making obviousness determinations.[3] The inevitable consequence of the methodological restrictions imposed by the Federal Circuit is that the Patent and Trademark Office all too often approves patents that are obvious on their face. The validity of these patents is generally upheld during litigation because lay judges and juries are reluctant to second-guess the patent examiner's perceived expertise. *See* Kimberly A. Moore, *Judges, Juries, and Patent Cases—An Empirical Peek Inside the Black Box*, 99 Mich. L. Rev. 365, 392 (2000) ("if the case makes it to trial . . . , the patentee holds a significant advantage in challenges to the patent").

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[3] On average, patent examiners spend only eighteen hours ensuring that a claimed invention satisfies the numerous prerequisites to patentability, including the detailed regulatory requirements of Title 37 of the Code of Federal Regulations, and the statutory novelty, utility, and non-obviousness requirements. *See* John R. Allison & Mark A. Lemley, *The Growing Complexity of the United States Patent System*, 82 B.U. L. Rev. 77, 135 (2002).

Moreover, the Federal Circuit's desire to prevent hindsight-based obviousness determinations (Pet. App. 6a-7a) is a wholly inadequate justification for use of the "teaching, suggestion, or motivation" test. As an initial matter, it is far from clear that judges, especially Federal Circuit judges experienced in patent matters, would succumb so easily to the lure of hindsight. In the absence of a well-documented pattern of courts invalidating patents possessing strong indicia of non-obviousness, it must be presumed that judges will be able to exclude hindsight from their obviousness inquiries. In any event, even if the use of hindsight were a known flaw in courts' obviousness determinations, the significant costs associated with the "teaching, suggestion, or motivation" test—most notably, the proliferation of patents claiming simple combinations of the prior art—vastly outweigh any benefits generated by the Federal Circuit's test.

2. By granting exclusive rights to ideas that should be at the disposal of all members of the public engaged in innovative efforts, patents on obvious combinations substantially impede technological development.

The flood of legally doubtful combination patents generated by the "teaching, suggestion, or motivation" test constitutes a significant obstacle to developing innovative technologies. For example, companies may have to pay a licensing fee for the right to use a patented combination, even where the combination—though deemed non-obvious under the Federal Circuit's "teaching, suggestion, or motivation" test—would have been obvious to anyone possessing ordinary skill in the relevant field. These licensing fees inevitably increase research costs and result in higher prices for consumers.

Moreover, the difficulty of establishing obviousness under the Federal Circuit's "teaching, suggestion, or motivation" test affords companies an incentive to redirect their research efforts away from truly novel projects toward com-

paratively straightforward combinations of existing technology. *See* Rebecca S. Eisenberg, *Obvious to Whom? Evaluating Inventions from the Perspective of PHOSITA*, 19 Berkeley Tech. L.J. 885, 890 (2004) ("The Federal Circuit has deployed judicial review in ways that make it harder to establish nonobviousness .... In the process, it has ... permitted the issuance of patents on routine advances within easy reach of technological practitioners of ordinary skill."). Due to the vast number of patents approved by the Patent and Trademark Office under the auspices of the Federal Circuit's "teaching, suggestion, or motivation" test, innovative research companies occasionally—and inadvertently—trip over one or more of these ubiquitous combination patents. The company is then faced with the Hobson's choice of settling the inevitable infringement action by paying a licensing fee for a patent that does nothing more than remove existing knowledge from the public domain, or attempting to vindicate its rights in court, where its efforts to demonstrate the patent's invalidity will be significantly hampered by the Federal Circuit's requirement that it identify a *specific* element of the prior art that taught the combination in question.

This is a particularly difficult standard to meet in the high-technology fields. The semiconductor and software industries do not have an extensive publication tradition, and when researchers do publish, they are unlikely to discuss obvious developments, such as the combination of two preexisting elements, instead focusing on more significant technological developments. *See* Eisenberg, *supra*, at 897-98 ("The gap between the skill of ordinary practitioners and the written record of prior art is likely to be particularly significant in industrial technology, with its prevailing culture of secrecy and few incentives to publish."). The search for prior art teachings is further impeded by the fact that obvious information need not be included in a patent's written description, which diminishes the likelihood that existing patents will specifically suggest an obvious combination. *See S3 Inc. v.*

nVIDIA Corp., 259 F.3d 1364, 1371 (Fed. Cir. 2001) ("The law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention.").

Even if an innovative company could be confident that it will eventually satisfy the exacting "teaching, suggestion, or motivation" test, it almost invariably must endure the risk and expense of a trial to do so. Although a factual inquiry into the knowledge of persons skilled in the relevant art is a proper step in determining whether a patent is obvious, the obviousness inquiry is ultimately a question of law. *See Graham*, 383 U.S. at 17. Under the Federal Circuit's standard, however, fact-intensive issues predominate—including inquiries into the subjective motivations of persons skilled in the art and the implications that could be gleaned from prior art teachings—which makes it nearly impossible for a district court to grant summary judgment on obviousness grounds.[4] Indeed, as even the Federal Circuit has acknowledged, it is extremely rare for an infringement defendant to be able to identify a prior art reference that specifically and unambiguously teaches the pertinent combination. *See In re Johnston*, 435 F.3d 1381, 1385 (Fed. Cir. 2006) ("An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art."). Accordingly, it is virtually inevitable that there will be disputed factual issues requiring a trial and an ensuing "battle of the experts" regarding the state of the prior art and the motivations

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[4] *See, e.g., Transocean Offshore Deepwater Drilling, Inc. v. GlobalSantaFe Corp.*, No. H-03-2910, 2006 U.S. Dist. LEXIS 54727 (S.D. Tex. Aug. 7, 2006); *Cryovac Inc. v. Pechiney Plastic Packaging, Inc.*, 430 F. Supp. 2d 346 (D. Del. 2006); *IMX, Inc. v. Lendingtree, LLC*, 405 F. Supp. 2d 479 (D. Del. 2005); *Toro Co. v. Scag Power Equip., Inc.*, 241 F. Supp. 2d 1057 (D. Neb. 2003).

of persons skilled in the relevant field—a fact illustrated by the decision below, where the Federal Circuit reversed the district court's grant of summary judgment to KSR and remanded the case for further consideration of the obviousness question. Pet. App. 16a; *see also Knoll Pharm. Co. v. Teva Pharm. USA, Inc.*, 367 F.3d 1381, 1385 (Fed. Cir. 2004) (reversing a grant of summary judgment because there were disputed issues of fact regarding obviousness); *Rockwell Int'l Corp. v. United States*, 147 F.3d 1358, 1366 (Fed. Cir. 1998) (same).

For Intel, Micron, and their peer companies, the nearly insurmountable difficulty of obtaining summary judgment on obviousness grounds increases the pressure to settle, even where the patent at issue is seemingly obvious on its face. Ultimately, whatever course Intel and Micron choose—settlement or litigation—they are required to divert funds that could have otherwise financed research efforts to respond to the infringement claim of a company holding a legally doubtful patent. Under the patentability standard implicit in the Patent Clause, however, such prior art combinations should be freely available for use by all members of the public, unless they represent a substantial contribution to the relevant field of knowledge. *See Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979) ("the stringent requirements for patent protection seek to assure that ideas in the public domain remain there for the free use of the public").

These experiences are by no means unique to Intel, Micron, and other high-technology firms. This Court long ago recognized the pernicious effects occasioned by indiscriminately issuing patents for obvious claims. "It was never the object of [the patent] laws," this Court explained when invalidating a patent that claimed an inconsequential improvement of the prior art, "to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an

indiscriminate creation of exclusive privileges," the Court continued, "tends rather to obstruct than to stimulate invention . . . [by] embarrass[ing] the honest pursuit of business with fears and apprehensions of . . . unknown liabilities to lawsuits and vexatious accountings for profits made in good faith." *Atl. Works*, 107 U.S. at 200.

To ensure that patents truly foster innovation—as the Constitution mandates that they do—this Court should reject the Federal Circuit's "teaching, suggestion, or motivation" test, which rewards routine discoveries at the expense of true innovation. As discussed below, the appropriate obviousness standard is clearly set forth in *Graham* and the plain language of 35 U.S.C. § 103.

II. The "Teaching, Suggestion, Or Motivation" Test Conflicts With This Court's Well-Settled Precedent.

The "teaching, suggestion, or motivation" test finds no license in this Court's obviousness jurisprudence or the statutory language of 35 U.S.C. § 103. This Court should reorient the obviousness inquiry to require an objective comparison between the purported invention, on the one hand, and the state of the prior art and the knowledge of an ordinary person skilled in the art, on the other. That standard is firmly entrenched in this Court's precedent and embodied in the text and history of Section 103.

1. Long before the requirement of non-obviousness was codified in 1952, this Court recognized the need to distinguish between patentable inventions that represent a substantial advancement of the prior art and unpatentable developments "destitute of ingenuity or invention." *Hotchkiss*, 52 U.S. (11 How.) at 266.[5] In *Hotchkiss*, for example—the case

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[5] *See also Dunbar v. Myers*, 94 U.S. 187, 197 (1876) ("Invention or discovery is the requirement which constitutes the foundation of

that gave rise to the obviousness doctrine (*see Graham*, 383 U.S. at 3-4)—this Court held that a device for producing doorknobs was not patentable because the invention merely substituted clay or porcelain for metal or wood as the material for fabricating the doorknobs. *Hotchkiss*, 52 U.S. (11 How.) at 265. The Court explained that, "unless more ingenuity and skill . . . were required" to develop the invention "than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention." *Id.* at 267.

This distinction—between patentable inventions evidencing ingenuity and innovation, and unpatentable advances reflecting routine knowledge of the relevant art—was consistently recognized in this Court's decisions preceding the codification of the obviousness standard. *See, e.g., Dunbar*, 94 U.S. at 195 (holding that a patent for a saw with a deflecting plate attached to both sides was invalid because a saw with the deflecting plate on one side had already been patented, and explaining that any "[o]rdinary mechanic[] . . . would know how to arrange a deflecting plate at one side of a circular saw which had such a device properly arranged on the other side"); *Packing Co. Cases*, 105 U.S. at 572 (holding that a change in the process for cooking meats for purposes of preservation and packing was not patentable because the idea "would naturally occur to any one engaged in the business of packing such food").

[Footnote continued from previous page]

the right to obtain a patent."); *Packing Co. Cases*, 105 U.S. 566, 571-72 (1882) ("All improvement is not invention, and entitled to protection as such. Thus to entitle it, it ought to be the product of some exercise of the inventive faculties, and it must involve something more than what is obvious to persons skilled in the art." (internal quotation marks omitted)).

When applying the *Hotchkiss* obviousness standard, the Court reserved especially exacting scrutiny for patents that claimed a combination of two prior art references, explaining that "[c]ourts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements." *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 152 (1950). In *Reckendorfer v. Faber*, 92 U.S. 347 (1876), for example, the Court held that a combination of a pencil and eraser was unpatentable because "[e]ach . . . continues to perform its own duty, and nothing else. No effect is produced, no result follows, from the joint use of the two." *Id.* at 356. The Court explained that the combination was "the result of mechanical skill merely," which is not patentable. *Id.*; *see also id.* ("Mechanical skill is one thing; invention is a different thing."); *see also Heald v. Rice*, 104 U.S. 737, 755 (1882) (where "no inventive resource [is] drawn upon to bring . . . together" the components of a new device, the combination is not patentable).[6]

In none of these cases did the Court inquire whether there was a specific "teaching, suggestion, or motivation" to combine the prior art elements. The Court instead consistently adhered to the rule that a technological development was unpatentable if it would have been obvious to a person possessing ordinary skill in the relevant art. Congress codified this obviousness standard as 35 U.S.C. § 103. *See Gra-*

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[6] Indeed, it is likely that a number of this Court's obviousness decisions would have come out differently under the "teaching, suggestion, or motivation" test. There is no indication in the Court's *Reckendorfer* opinion, for example, that a prior art reference existed teaching or suggesting the combination of a pencil or eraser. Due to the absence of such a prior art reference, the patents at issue could have been deemed non-obvious under the Federal Circuit's standard, notwithstanding the stark obviousness of combining a pencil and eraser.

ham, 383 U.S. at 17 (Section 103 "was intended merely as a codification of judicial precedents embracing the *Hotchkiss* condition, with congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability").

2. The framework for obviousness determinations under Section 103 builds upon *Hotchkiss* and its progeny. In *Graham*, this Court directed lower courts to undertake a statutory obviousness inquiry that considers the content of the prior art, the differences between the prior art and the claimed invention, and the knowledge of a person with ordinary skill in the relevant art. 383 U.S. at 17.[7] The existence of a specific "teaching, suggestion, or motivation" to combine prior art references has no place in *Graham*'s obviousness framework.

In *Graham* itself, the Court held that a device designed to absorb shock from plow shanks was obvious because "a person having ordinary skill in the prior art . . . would [have] immediately see[n]" the technological advance claimed by the applicant. 383 U.S. at 25. Similarly, in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), the Court held that a patent for an asphalt-paving device was invalid because it was merely a combination of previously known elements that would have been obvious to someone skilled in the relevant art. *Id.* at 62; *see also Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976) (holding that a system for flushing manure from barns was not patentable because it "add[ed] nothing to the sum of useful knowledge . . . [and] would [have] be[en] obvious to any person skilled in the art" (internal quotation marks and alteration omitted)). The pres-

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[7] Certain "secondary considerations"—including commercial success, long felt but unresolved needs, and the failure of others in the field—may also be relevant to the obviousness inquiry. *Graham*, 383 U.S. at 17.

ence or absence of specific teachings, suggestions, or motivations was irrelevant to the Court's conclusion in these cases.

The Federal Circuit has strayed far from these jurisprudential moorings by shifting the focus of the obviousness inquiry away from the knowledge possessed by a person with ordinary skill in the relevant field and instead requiring "some suggestion, teaching, or motivation that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed." Pet. App. 6a. This standard conflicts with more than a century of this Court's decisions, which have consistently evaluated the obviousness of a claimed invention from the perspective of a person skilled in the relevant art.[8]

In light of the profoundly adverse effect of the "teaching, suggestion, or motivation" test upon the United States patent system, this Court should reaffirm *Graham* and reiterate that the obviousness of a patent is to be determined through an evaluation of the knowledge of someone with ordinary skill in the relevant art and a consideration of the differences between the prior art and the claimed invention. 383 U.S. at 17. This standard is consistent with the Patent Clause's implicit patentability restrictions, this Court's precedent, and the plain language of Section 103.

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[8] The fact that the requisite "teaching, suggestion, or motivation" may be implicit in the prior art, and thus need not be expressly stated, does not save the Federal Circuit's standard from infirmity. *See, e.g., Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1277 (Fed. Cir. 2004). Any requirement that a party challenging the validity of a patent on obviousness grounds demonstrate a teaching, suggestion, or motivation—express or implied—is inconsistent with this Court's decisions evaluating obviousness based upon the knowledge of a person possessing ordinary skill in the relevant art, rather than upon the implicit teachings of the prior art or the subjective motivations of persons practicing that art. *See, e.g., Graham*, 383 U.S. at 25.

CONCLUSION

For the foregoing reasons, the judgment of the court of appeals should be reversed.

Respectfully submitted.

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August 22, 2006